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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78462025
Applicant	Mid-America Group, Ltd.
Applied for Mark	MID-AMERICA GROUP
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Date	02/13/2007

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IN RE: Mid-America Group, Ltd.	)	
	)	
SERIAL NO: 78/462,025	)	Appeal No. _____
	)	
MARK: MID-AMERICA GROUP (Logo)	)	
	)	
FILED: August 4, 2004	)	
	)	
LAW OFFICE: 106	)	
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Trademark Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1451  
Alexandria, VA 22313-1451

**REPLY BRIEF**

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Dear Sir:

## **I. INTRODUCTION**

Please enter the following Reply Brief into the record. It responds to the Examining Attorney's request to affirm the refusal of registration of the above-stated mark over U.S. Registration No. 2,444,425 ("the '425 mark"). The refusal to register Appellant's mark can only be affirmed if the well established anti-dissection rule is thrown out the window in favor of the Examining Attorney's piecemeal approach in finding similarity between the respective marks. Appellant urges the Board to reverse the Examining Attorney's refusal to register Appellant's mark.

## **II. DIFFERENT COMMERCIAL IMPRESSIONS IN THEIR ENTIRETIES**

The Examining Attorney once again hinges the refusal to register Appellant's mark on the argument that the respective marks create the same commercial impression. Appellant urges the Board to compare the marks in their entireties as the Supreme Court established in 1920. *See Estate of Beckwith, Inc. v. Commr. of Patents*, 225 U.S. 538, 545-46 (1920) ("The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason, it should be considered in its entirety."). When the marks are compared in their entireties, the only conclusion that can and should be reached is that the marks create distinctly different commercial impressions. The simple fact that the marks have some similarities is not enough to support that they are similar overall. There are significant differences between the marks; thus the commercial impressions would be different. *See, e.g., The Falk Corp. v. Toro Mfg. Corp.*, 181 U.S.P.Q. 462, 467 (CCPA 1974) (Difference between TOTO and TORUB contributed to a finding of no likelihood of confusion); *Lever Brothers Co. v. The Barcelone Co.*, 174 U.S.P.Q. 392, 292 (CCPA 1992) ("While appellant points out some

similarities between the word ALL as it is used by both parties, inspection of the two marks [ALL and design and ALL CLEAR! and design] also shows some obvious differences. Considering appellee's mark in its entirety, we are convinced that there is no likelihood of confusion"); and *In re Gen. Elec. Co.*, 134 U.S.P.Q. 190 (CCPA 1962) (VULCAN and VULKENE not similar). As with the case at bar, the differences between Appellant's mark and the '425 mark overwhelm the similarities. The differences in the services offered under the respective marks, along with the sophistication of the purchasing customer, support the allowance of Appellant's application as they are not competitors for the same type of business and, thus, would not impede either company's commercial efforts.

A. MARKS ARE INAPPROPRIATELY DISSECTED

In the Examining Attorney's Appeal Brief, the marks continue to be impermissibly dissected with only a portion of the marks compared. Examining Attorney's Appeal Brief, page 3. Specifically, the Examining Attorney dissects MID AMERICA from the respective marks for comparison, discarding the remainder of each of the marks. Based on this dissection, the Examining Attorney goes on to wrongly conclude the word portion of the mark is dominant and, therefore, the words alone are the commercial impression. Examining Attorney's Appeal Brief, pages 3-4. The Court of Appeals for the Federal Circuit has cautioned that '[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue.'). *Electrolyte Laboratories Inc.*, 16 U.S.P.Q.2d 1239, 1240 (Fed. Cir. 1990). The comparison of composite marks must be done on a case-by-case basis without reliance on mechanical rules of construction such as those employed by the Examining Attorney in this case. See e.g., *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 184 U.S.P.Q. 35 (CCPA 1974) (finding no likelihood of confusion between SPICE TREE and tree

design and SPICE ISLANDS and tree design, both for spices). Although it is not improper to give greater force and effect to a dominant feature of a mark, the fundamental rule is that marks must be considered in their entireties. *E.g., Massey Junior College, Inc. v. Fashion Inst. of Tech.*, 181 U.S.P.Q. 272 (C.C.P.A. 1974). The Examining Attorney fails to do so in the instant matter.

Along with the wording, the logo portions of the respective marks are important in determining the overall commercial impression of the marks. The logos are different in appearance and location. The '425 mark has a small logo before any words, which is of equal size to the words. Appellant's logo has a different, much larger logo, up to the right of the words. It cannot be denied that the eye is instantly drawn to the angled block logo of Appellant's mark. It is twice as large as the word portion, and the blocks lean together in an attractive way, which upon a second glance, creates the impression of an "M" and "A." There is nothing comparable in the cited registration. As everyone knows, a picture is worth a thousand words and here the picture is different. Therefore, the reality is that a different commercial impression is created by Appellant's mark which is dominated by the graphics.

Additionally, the Examining Attorney impermissibly considers a factor of the '425 mark, that of the stylized letter "M" that is not part of the legal record of the '425 application. This is acknowledged by the Examining Attorney's on page 4 of Appeal Brief where he states: "Furthermore, the fact that applicant's mark contains a stylized letter "M" (as it would appear so does the registered mark, although no mark description appears upon the registration certificate)" . . . . (emphasis added). Nowhere in the trademark file of the '425 mark does the applicant address any stylized letter as part of its mark. Much like the well settled law that the question of likelihood of confusion must be determined based on an analysis of the goods or services recited

in applicant's application vis-à-vis the goods or services recited in the registration rather than what the evidence actually shows regarding the goods or services, the basis for analysis of a mark must be supported by what is contained in the record and, in the instant case, there is nothing in the record which even remotely suggests that a stylized "M" is part of the '425 mark. E.g., *Octocom Sys., Inc. v. Houston Computer Services, Inc.*, 16 U.S.P.Q.2d 1783 (Fed. Cir. 1990).

The Examining Attorney's dissection of the marks runs contrary to the well established law of *Beckwith* and goes well beyond any reasonable and permissible standard in a likelihood of confusion analysis. To hold other than reversing the Examining Attorneys' refusal to register would be pulling the rug out from under well established law that has been in place for nearly 85 years.

#### B. SERVICES RUN IN DIFFERENT CHANNELS OF TRADE

The Examining Attorney incorrectly contends that the services provided under the respective marks "concern the same field of business" and that "the real estate development services of applicant can or will involve the need for real estate brokerage and management services." Examining Attorney's Appeal Brief, page 5. The Examining Attorney fails to offer any factual basis for the contention that those in the "development" arena will need real estate brokerage and management services. The Examining Attorney must provide more than unsupported conjecture.

Additionally, the Examining Attorney asserts that it is common practice for development services and brokerage and management services to be performed under the same service mark, and references in support thereof previously cited third party registrations. Examining Attorney's Appeal Brief, page 5. This argument is nonsensical. The Coca-Cola Company owns U.S. Reg.

No 2,844,964 for goods in International Class 20 that includes step stools, drinking straws, plastic novelty license plates, air mattresses for use when camping, non-electric fans, mirrors, figurines and Christmas stocking holders, bar stools, dispenser for pills or capsules, jewelry boxes, shower hooks, ottomans, and ceramic fan pulls. To carry the Examining Attorney's reasoning to its illogical conclusion, drinking straws must also be considered to be "related" to Christmas stocking holders since both types of goods appear in the same registration. It is submitted that just because of the mere fact that two different types of services are listed within the same registration does not conclude that the services are "related" for purposes of Trademark Act Section 2(d). Once again, the Examining Attorney's argument is without merit.

#### C. CONSUMER SOPHISTICATION

The Examining Attorney discounts consumer sophistication in the misplaced argument that services listed in the same registration are "related" and thus will cause consumer confusion as to the source of those services. Examining Attorney's Appeal Brief, page 6. As argued above, the Examining Attorney fails in the logic of "related" services. Sophistication or care of the purchaser weighs against a likelihood of confusion where cost is a factor or where particular expertise is possessed by the consumer, even when the goods or services fall within the same general class or are used together. *E.g., In re NexGen Resources Corp.*, (TTAB, August 10, 2006); *Foseco Intl. Ltd. v. Ashland Oil, Inc.*, Opp. No. 90,496 (TTAB 1997); *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 212 U.S.P.Q. 246, 252 (1st Cir. 1981). Consumers who are builders and realtors, and corporate executives and real estate professionals have been held to be "professional buyers" who exercise a higher degree of care in purchasing goods and services. *Astra Pharm. Products v. Beckman Instruments, Inc.*, 220 U.S.P.Q. 786, 790-91 (1st Cir. 1983); *Allstate Ins. Co. v. Allstate Inv. Corp.*, 136 U.S.P.Q. 156 (W.D. La. 1962), *aff'd*, 141

U.S.P.Q. 280 (5th Cir. 1964). Given that the purchasers of services offered under both Appellant's mark and the '425 mark would be realtors or real estate professionals and, thus, would be highly knowledgeable, discriminating and sophisticated consumers, there is little likelihood of confusion between real estate development services offered under Appellant's mark and real estate brokerage and management services offered under the '425 mark.

### **III. CONCLUSION**

For the above-stated reasons, as well as Appellant's comments in its Appeal Brief, Appellant's composite mark, MID AMERICA GROUP, is not confusingly similar to the '425 mark. Appellant therefore respectfully requests that the Examining Attorney's refusal to register Appellant's mark be reversed and the application be forwarded for publication.

Respectfully submitted,

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